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IN THE

# Supreme Court of the United States,

OCTOBER TERM, 1926.

No. 9[redacted] 194

BARBER ASPHALT PAVING COMPANY,
*Petitioner,*

*against*

STANDARD ASPHALT & RUBBER COMPANY,
*Respondent.*

## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT, AND BRIEF IN SUPPORT THEREOF.

JOHN W. DAVIS,
CHARLES NEAVE,
SAMUEL E. HIBBEN,
HENRY N. PAUL,
*Attorneys for Petitioner.*

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IN THE

# Supreme Court of the United States,

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| BARBER ASPHALT PAVING COMPANY, Petitioner, vs. STANDARD ASPHALT & RUBBER COMPANY, Respondent. | No. |

## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

TO THE HONORABLE THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Barber Asphalt Paving Company respectfully prays for a writ of certiorari to review the decree of the United States Circuit Court of Appeals for the Seventh Circuit in the above entitled suit.

### Statement of the Case.

Barber Asphalt Paving Company is a Corporation of the State of West Virginia, having its principal office in the City of Philadelphia, State of Pennsylvania.

The suit in which the decree sought to be reviewed was rendered was brought by the respondent against the petitioner in the District Court of the United States for the Southern

District of Illinois, for the infringement of United States Letters Patent Nos. 635,429 and 635,430. The said District Court (Judge Humphrey presiding) entered a decree finding infringement, ordering an accounting and appointing a Master (Record, pp. 1217-9). Judge Humphrey died before the accounting was concluded.

As the result of the accounting before the Master a final decree was entered by said Court (Judge Fitz Henry presiding) on April 30, 1924, awarding respondent the sum of $650,044.83 with interest from January 6, 1921 (Record, pp. 4676-7). Petitioner duly appealed to the Circuit Court of Appeals for the Seventh Circuit, which appeal was perfected July 5, 1924 (Record, p. 4685). The record on said appeal was, on the Petitioner's motion, returned to the said District Court for correction. On March 30, 1926, the said District Court entered an order directing "that all the testimony in this cause be reproduced in the exact words of the witness and not in narrative form"; and further ordering that the said statement of evidence as incorporated in the transcript of the record be "hereby approved as a true, complete and properly prepared statement of the evidence" (Record, pp. 4913-4915). A copy of said order is appended to the Brief herewith submitted as Appendix A.

Upon the record as so corrected and authenticated the said cause came on for argument on October 6, 1926, before the Honorable Evan A. Evans, George T. Page and Albert B. Anderson, and was fully argued upon the merits and taken under advisement by the Court.

On December 13, 1926, the said United States Circuit Court of Appeals for the Seventh Circuit handed down an opinion affirming the decree below upon the sole grounds that there had been a failure to comply with Equity Rule No. 75 (b) in that the evidence included in the Record had not been stated in narrative form, but had been set forth in full, and that the District Judge had no power to make the order of March 30, 1926, referred to above, directing that such evidence should

be reproduced in the words of the witnesses and not in narrative form (Record, p. 4992; Appendix A, p. 23, *infra*).

Petitioner thereupon (December 31, 1926, Record, p. 4999) moved for a re-hearing, and also specifically moved for an opportunity to amend the record in accordance with the Court's interpretation of the rule as announced in its said opinion. Said motions were denied January 24, 1927 (Record, p. 5132).

This writ is sought to review the decision and order of the Circuit Court of Appeals.

Contemporaneously with the submission of this petition, a motion is being made in this Court for leave to file a petition for an order to show cause why a writ of mandamus should not issue to compel the judges of said Circuit Court of Appeals to consider the cause on the merits, or in the alternative, to make an order directing the District Court to entertain procedure in accordance with Rule 75 (b) to prepare a record amended in accordance with the requirements of that Rule as now interpreted by said Circuit Court of Appeals.

The opinion of the said Circuit Court of Appeals affirming the judgment of the District Court has not yet been reported, but appears in the Record (p. 4992), and is also, for convenience, printed as Appendix B to the brief herewith submitted.

## Jurisdiction of the Court.

This application is made under Section 240 of the Judicial Code, as amended by the Act of February 13, 1925 (43 Stat. 938).

## Reasons for Application for the Writ and Questions Presented.

I. An important question of Federal Law has been decided by the Circuit Court of Appeals which has not been, but should be, settled by this Court.

II. Was the Circuit Court of Appeals right in holding that no evidence was properly before it on this appeal, and that therefore the merits of the cause could not be considered, notwithstanding that there was before the said Court a statement of the evidence which the District Court has certified to be "true, complete and properly prepared"?

III. Did the Circuit Court of Appeals exceed its power in affirming the judgment and refusing to consider your petitioner's appeal upon the merits without affording it an opportunity to comply with the provisions of said Rule 75 (b) as now interpreted by said Court?

IV. Assuming that the interpretation of Rule 75 now enounced by the Circuit Court of Appeals is correct and that it has the power to refuse to consider petitioner's appeal on the merits because said rule as so enounced has not been complied with, did the said Court fail to exercise a sound discretion in affirming the judgment in this cause without considering the merits and without affording the petitioner an opportunity to comply with said rule as now interpreted by it?

WHEREFORE, your petitioner respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Seventh Circuit, and submits its brief hereto attached in support of this petition.

Respectfully submitted,

JOHN W. DAVIS,
CHARLES NEAVE,
SAMUEL E. HIBBEN,
HENRY N. PAUL,
Attorneys for the Petitioner.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1926.

| | |
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| BARBER ASPHALT PAVING COMPANY, Petitioner, against STANDARD ASPHALT & RUBBER COMPANY, Respondent. | No. |

## BRIEF IN SUPPORT.

POINT I.

THE CIRCUIT COURT OF APPEALS HAS DECIDED IN THIS CAUSE AN IMPORTANT QUESTION OF FEDERAL LAW WHICH HAS NOT BEEN, BUT SHOULD BE, SETTLED BY THIS COURT.

POINT II.

THE CIRCUIT COURT OF APPEALS ERRED IN HOLDING THAT NO EVIDENCE WAS PROPERLY BEFORE IT ON THIS APPEAL, AND THAT THEREFORE THE MERITS OF THE CAUSE COULD NOT BE CONSIDERED, NOTWITHSTANDING THAT THERE WAS BEFORE THE SAID COURT A STATEMENT OF THE EVIDENCE WHICH THE DISTRICT COURT HAS CERTIFIED TO BE "TRUE, COMPLETE AND PROPERLY PREPARED."

POINT III.

THE SAID CIRCUIT COURT OF APPEALS HAS EXCEEDED ITS POWERS BY AFFIRMING THE JUDGMENT AGAINST THE PETITIONER IN THIS CAUSE WITHOUT AFFORDING IT AN OPPORTUNITY TO CONFORM TO EQUITY RULE 75 AS NOW INTERPRETED BY SAID COURT.

POINT IV.

ASSUMING THAT THE INTERPRETATION OF EQUITY RULE 75 ENOUNCED IN THIS CAUSE IS CORRECT AND THAT IT IS WITHIN THE POWER OF THE COURT TO REFUSE TO CONSIDER AN APPEAL UPON THE MERITS BECAUSE SAID RULE AS SO ENOUNCED HAS NOT BEEN COMPLIED WITH, THE SAID CIRCUIT COURT OF APEALS HAS FAILED IN THIS CAUSE TO EXERCISE A SOUND DISCRETION IN THAT IT HAS REFUSED TO CONSIDER PETITIONER'S APPEAL UPON THE MERITS AND AFFIRMED THE JUDGMENT WITHOUT AFFORDING IT AN OPPORTUNITY TO COMPLY WITH SAID RULE 75 AS NOW INTERPRETED BY IT.

(a) The practice in the Seventh Circuit prior to the decision in this case.

(b) The history of this particular record.

## POINT I.

**The Circuit Court of Appeals in this cause has decided an important question of federal law which has not been, but should be, settled by this Court.**

The decision of the Circuit Court of Appeals which this Court is asked to review as shown by its opinion (Rec., p. 4992; Appendix B) rests solely upon the grounds that the testimony of the witnesses was not reduced to narrative form, but was set forth in full in violation of Equity Rule 75, and that the Judge who made the order of March 30th, 1926 (Rec., pp. 4913-15) directing that such testimony "be reproduced in the exact words of the witnesses and not in narrative form", and that such statement of evidence be "hereby approved as a true, complete and proper statement of the evidence", had no power to make any such order.

It is, of course, conceded that the Equity Rules made by this Court are so made under statutory authority and have

the force of statutes; and that the Circuit Courts of Appeals and District Courts have no power to dispense with them.

But it must be well known to this Court that Equity Rules 75 and 76 have received very diverse constructions, or have at least been very differently applied in the several Circuits.

Such variances of construction or application are doubtless due in large part at least to the individual preferences of the Judges constituting the different Circuit Courts of Appeals. In some Circuits the reduction of the testimony to narrative form, as required by Rule 75(b) is popular with the Judges composing the Court, and those Courts have announced their preference in no uncertain manner.

> Sixth Circuit C. A., *In re General Equity Rule* 75, 222 Fed. 884;
>
> Fifth Circuit C. A., *Buckeye Cotton Oil Co.* v. *Ragland*, 11 Fed. (2nd), 231.

In other Circuits, on the contrary, the Judges of the Circuit Court of Appeals prefer to have before them the full testimony of the witnesses by question and answer in the sincere belief that this method of presentation gives them the better impression of what the evidence really is, and facilitates them in reaching a correct decision. (*United States* v. *Motion Picture Patent Co.* (D. C., E. D. Penna. 1916) 230 Fed. 541, 542.) They have, therefore, exercised wide latitude in construction of the Rule, and have interpreted the provision of (b) of Rule 75 "that if either party desires it, and the court or Judge so directs, *any part* of the testimony shall be reproduced in the exact words of the witness" (Italics ours), to authorize the *entire* testimony to be so reproduced. This has been for years, and still is the practice in the Third Circuit. (Affidavit of Henry N. Paul, Record, p. 5038).

We expect to show under Point IV that the same practice was common and usual, especially in patent cases, in the

Seventh Circuit, up to the very instant of the decision which this Court is now asked to review.

Still other Circuit Courts of Appeals, while emphasizing the binding effect of the Rule upon them, and the importance of its observance, have exercised great liberality in accepting records which they considered did not fully comply with it, or have permitted the appellant to go back to the District Court and have the statement of evidence resettled, or stated that they would have done so had it been necessary.

Fifth Circuit, *Coxe* v. *Peck-Williamson Heating & Ventilating Co.*, 208 Fed. 409;
*Roxana Petroleum Co.* v. *Rush*, 295 Fed. 844;
*Buckeye Cotton Oil Co.* v. *Ragland*, 11 Fed. (2nd) 231;
Sixth Circuit, *Firestone Tire & Rubber Co.* v. *Eberling*, 235 Fed. 891;
Eighth Circuit, *Brictson Mfg. Co.* v. *Clone*, 280 Fed. 297;
Ninth Circuit, *Struett* v. *Hill*, 269 Fed. 247;
*Stennick* v. *Jones*, 282 Fed. 161.

The language of the Rule furnishes no guide as to how much or how little of the testimony may be reproduced by question and answer if either party desires it, and the Court or Judge so directs. This, therefore, is a matter that must necessarily be left to the discretion of the authority who approves the statement of evidence, which authority under the Rule is the Court from which the Appeal is prosecuted or a Judge thereof. This is necessarily a matter calling for the exercise of common sense and in respect of which no hard and fast rules can be laid down. We may be permitted to suggest that this Court has itself expressly recognized that the provision of the Rule requiring the reduction of the evidence or the bulk of it to narrative form is not inexorable, but that the Rule must receive a reasonable interpretation and that there may be exceptions to it.

*United States* vs. *United States Steel Corp.*, 240 U. S. 442.

In the case cited this Court recognized that Equity Rule 75 was not appropriate, and approved the filing of a Record containing the whole testimony in its original shape.

The decision of the Circuit Court of Appeals in this case raises squarely the question whether the provision of Equity Rule 75 permitting "any part" of the testimony to be reproduced in the record in question and answer form "if the Court or Judge so directs" authorizes the entire testimony to be so reproduced if that seems to the court or judge the best manner of presenting it to the appellate court in the particular case. This, it is submitted, is a question of far reaching importance which should be definitely settled by this Court.

## POINT II.

**The Circuit Court of Appeals erred in holding that no evidence was properly before it on this appeal, and that therefore the merits of the cause could not be considered, notwithstanding that there was before the said Court a statement of the evidence which the District Court has certified to be "true, complete and properly prepared."**

Equity Rule 75 places upon the *District* Court or Judge the full responsibility of deciding what the statement of evidence to be incorporated in the record on appeal shall contain. The last sentence of subdivision (b) of the Rule directs that when such statement has been approved by the District Court or Judge "it shall be filed in the Clerk's office and *become a part of the record for the purposes of the appeal.*" (Italics ours). When the District Court or Judge

has certified a statement of evidence as "true, complete and properly prepared," and such statement has been filed in the Clerk's office as prescribed, the Circuit Court of Appeals can not take the position that no evidence is before it. If it is of opinion that the evidence is too much or too little condensed, it has the power to direct the District Court as to how it desires the record made up. Such procedure is analogous to the ordering of a new trial when erroneous rulings, prejudicial to the appellant, have been made by the trial judge. But it cannot treat the certificate of the District Court or Judge as a nullity and refuse to consider the appeal on the merits because *no* evidence is presented by the record.

Rule 76 supports this position. It expressly declares that: "If, in the transcript, *anything material to either party be omitted by accident or error*, the appellate court, on a proper suggestion or its own motion, may direct that the omission be corrected by a supplemental transcript." (Italics ours).

It will be seen that it is not necessary for the appellate court to send back the entire record for the purpose of curing what it considers defects therein. The certificate of evidence is only *part* of the record, and the omission of what the appellate court considers a *proper* certificate can be amended by a supplemental transcript. This can be done at any time, since the District Court does not lose its power to settle the evidence in equity causes because a term has expired, or an appeal been perfected.

*In re General Equity Rule* 75, 222 Fed. 884;
*Struett* v. *Hill*, 269 Fed. 247;
*Sussex Land & Live Stock Co.* v. *Midwest Refining Co.*, 294 Fed. 597.

It is respectfully urged that the second paragraph of Rule 76 was intended to provide for exactly such a situation as the Circuit Court of Appeals considered was before it in this case, and that it should have directed correction of the

record by supplemental transcript, instead of totally disregarding the certificate of the District Judge, and affirming the judgment because, as it held, the evidence was not properly before it.

Furthermore, petitioner maintains that the action of the Circuit Court of Appeals in affirming the judgment without considering the record as before it, or directing its correction, was in violation of Section 269 of the Judicial Code as amended by Act of February 26, 1919, enacted since the adoption of Rule 75. This aspect of the case will be discussed under Point III following.

## POINT III.

**The said Circuit Court of Appeals has exceeded its powers by affirming the judgment against the petitioner in this cause without affording it an opportunity to conform to Equity Rule 75 as now interpreted by said Court.**

By Act approved February 26, 1919, 40 Stat. 1181, the Congress amended Section 269 of the Judiciary Code to read as follows:

> "Section 269. All of the said courts shall have power to grant new trials, in cases where there has been a trial by jury, for reasons for which new trials have usually been granted in the courts of law. **On the hearing of any appeal, certiorari, writ of error, or motion for a new trial, in any case, civil or criminal, the court shall give judgment after an examination of the entire record before the court, without regard to technical errors, defects, or exceptions which do not affect the substantial rights of the parties.**"

The amendment consists of the addition of the second sentence, which is entirely new legislation.

It is contended by petitioner that the action of the Circuit Court of Appeals in this case was a violation not only of the spirit, but of the letter, of this enactment.

If the certificate of evidence before the Court was not in proper form, that irregularity was clearly a "technical defect," "not affecting the substantial rights of the parties." It was clearly the duty of the Court under the Statute either to disregard this defect, or to exercise its power to have it corrected by the District Court. The Court admits its refusal to consider the evidence, although no question raised by the errors assigned could be determined without such consideration (Rec., p. 4998). The *substantial* rights of the parties necessarily depended upon the consideration and decision of the assignments of error. The provision of the amendment that cases shall be considered without regard to technical defects is as mandatory as legislation can be—the court has no discretion whatever in the matter. The affirmance of the judgment upon the purely technical ground that a rule of procedure had not been complied with, especially when compliance might so readily have been obtained, was a denial of a substantial right of petitioner's, a palpable violation of the legislative intent, and reversible error.

Furthermore, the Court exceeded its jurisdiction by punishing petitioner's supposed failure to comply with Equity Rule 75 by affirmance of the judgment upon that ground. This court has itself, in Rule 76, prescribed the penalty for violation of Rule 75, and the Circuit Court of Appeals cannot vary this penalty, especially by imposing a far more severe one.

Rule 76 provides that

> "for any infraction of this or *any kindred rule*" (Italics ours).

costs may be imposed upon offending solicitors as well as parties. It says nothing about affirmance of judgments, dismissal of appeals, or any other such drastic punishment.

None of the Equity Rules are more "kindred" one to another than numbers 75 and 76.

*In re General Equity Rule 75*, 222 Fed. 884, 886.

The Court was therefore limited, if it conceived that there had been such an infraction of Equity Rule 75 as called for the punishment of someone, to the penalty prescribed in Rule 76. This Court, of course, has power to waive or modify its own rules (*United States* v. *United States Steel Corporation*, 240 U. S. 442; *Patterson* v. *Mobile Gas Co.*, 271 U. S. 131), but no such power is vested in the Circuit Court of Appeals. While this Court has suggested that it might dismiss an appeal for infraction of Rules 75 and 76 (*Newton* v. *Consolidated Gas Co.*, 258 U. S. 165, 173), no decision has been found where it has even intimated that such destructive power can be exercised by the lower courts.

That the imposition of costs under Rule 76 is the appropriate, if not the only penalty for infraction of Rule 75 is indicated in the following decisions:

*Coxe* v. *Peck-Williamson Heating & Ventilating Co.*, 208 Fed. 409.

*Garland* v. *Quinn*, 242 Fed. 267.

## POINT IV.

**Assuming that the interpretation of Equity Rule 75 enounced in this cause is correct, and that it is within the power of the Court to refuse to consider an appeal upon the merits because said rule as so enounced has not been complied with, the said Circuit Court of Appeals has failed in this cause to exercise a sound discretion in that it has refused to consider petitioner's appeal upon the merits, and has affirmed the judgment, without affording an opportunity to comply with said rule as now interpreted and enforced by it.**

This will appear upon consideration of—

(a) *The practice in the Seventh Circuit prior to the decision in this case;*

(b) *The history of this particular record.*

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(a) *The practice in the Seventh Circuit prior to the decision in this case:*

It appears beyond question that the usual practice in the Seventh Circuit, up to the time of the decision in this case, had been to consider appeals, especially in patent causes, upon records containing uncondensed transcripts of the evidence.

A search of the records of the Circuit Court of Appeals for the Seventh Circuit for over five years immediately preceding the filing of the petition for rehearing discloses over one hundred cases in which certified transcripts of all, or substantially all the evidence, in question and answer form, were brought before that Court and considered without

objection by it. These cases are listed in an appendix to said petition for rehearing, about 60 of them being patent cases (Record, pp. 5027, *et seq.*). In several the judges who approved the record were of those who concurred in the opinion affirming the judgment in this cause. We instance the following:

*Bestwall Manufacturing Co.* v. *U. S. Gypsum Co.*, No. 3693, November 4, 1925 (Judges Alschuler, Evans and Anderson).

*Wirebounds Co.* v. *Gibbons*, No. 3650, December 11, 1925 (Judge Evans).

*Fairbanks, Morse & Co.* v. *American Valve & Meter Co.*, No. 3776, May 17, 1926 (Judge Evans).

(Record, pp. 5018-19.)

Within a few days after handing down its opinion in this case, the Court enforced the same doctrine in disposing of several other appeals. Among these was the case of *R. W. Clark Manufacturing Co.* v. *Tablet and Ticket Co.*, No. 3740, decided December 22, 1926. Judge Alschuler, who did not sit in petitioner's case, took part in the *Clark* case and rendered a vigorous dissenting opinion, stating emphatically that the usual practice in the Seventh Circuit had been to consider appeals and dispose of them on the merits upon uncondensed reports of the oral testimony, particularly in patent cases. These opinions being unreported as yet, we append them as Appendices C (majority opinion) and D (dissenting opinion).

The facts that the practice in the Seventh Circuit has always been as stated by Judge Alschuler is confirmed by the affidavit of Samuel E. Hibben (Record, p. 5043), a practitioner in patent causes in that Circuit of great experience, extending over nearly thirty-five years.

We submit that the distinction drawn by Judge Alschuler between the *Clark* case and this, viz., that there was a stipulation in the *Clark* case, is immaterial. The learned Judge

is in error in asserting that counsel for the appellee in this case (in which he did not sit) "insistently proved and urged dismissal of the appeal because of non-compliance with the rule." As we expect to show, petitioner's counsel had every reason to believe that they were following the usual practice in the Seventh Circuit, and nothing was said or done to indicate the contrary to them until the Court announced its decision.

(b) *The history of this particular record:*

The record further establishes that petitioner's counsel, far from having any disposition to violate a rule of this Court or of the Circuit Court of Appeals, have taken throughout the utmost pains to present their record in the form which they believed would be most acceptable to the latter Court.

The affidavit of Henry N. Paul, one of the petitioner's counsel (Record, pp. 5037-41) shows in detail the history of this record. He shows that this very point as to the manner in which the testimony should be certified was the subject of most careful consideration, and that he relied upon the advice of his senior local counsel, Mr. Edward Rector (now deceased), who advised that in cases of this character in the Seventh Circuit it was preferable and usual to have the entire testimony certified in question and answer form (Record, p. 5037). The *praecipe* was accordingly drawn in conformity with this advice. No counter *praecipe* was ever filed by the appellee, and no objection was ever raised by it to the form in which the testimony was certified, except by motion to strike out certain parts of the transcript entirely (Record, p. 5038), although the record was returned on petitioner's motion to the District Court for the formal approval of the statement of evidence by a Judge thereof. The cause was argued on October 6, 1926, on the merits and the Court at that time gave no intimation that it would decline to consider the evidence on account of the manner in

which it was presented. The decision, therefore, was absolutely a bolt from the blue so far as petitioner's counsel were concerned.

In the prevailing opinion in *R. W. Clark Manufacturing Co.* v. *Tablet & Ticket Co.* (Appendix C), Judge Evans states that "For fourteen years the courts have appealed to the bar to comply with the rule" (Equity Rule 75), and that "they have scolded and they have threatened." The most diligent search has failed to disclose any reported case in which the Circuit Court of Appeals for the Seventh Circuit have made any such appeal, or have done any such threatening or scolding. They certainly did not threaten or scold counsel in this case in this respect, nor have counsel been able to learn of any instance in which minatory language has been so employed. The statements quoted are in direct conflict with Judge Alschuler's experience on that bench as stated by him in his dissenting opinion. As he says "this Court has at least impliedly, seemed to invite litigants to continue", the practice which it now condemns (Appendix D, p. 37). And, as shown above, Judge Evans has himself within a little over a year made or concurred in making at least three orders providing that the transcript of the record shall contain all of the testimony, reproduced in the exact words of the witnesses (*supra*, p. 15).

In *Newton* v. *Consolidated Gas Co.*, 258 U. S. 165, 173, Mr. Justice McReynolds suggests that one of the purposes of Equity Rules 75 and 76 was to protect litigants from unnecessary costs and delay. Judge Page uses language to the same effect in his opinion in the *Clark* case (Appendix C). It is at least debatable whether the labor necessary to reduce the testimony to narrative form does not entail a far greater expense, as well as delay, upon a litigant than the printing of the testimony as it was given. But it is humbly submitted that the solicitude expressed is of doubtful value to the litigant when, having already incurred the expense of printing the full record, he is denied a hearing upon the merits of his

appeal merely because he has assumed the expense and incurred the possible delay in question.

Search has been made in vain for any reported case where what Judge Alschuler aptly terms "the capital penalty" of affirmance for appellant's failure to comply with Rule 75 has been enforced. In a number of cases (in some of the other circuits) the Courts have "scolded", and sometimes even "threatened", but it is not found that the "capital penalty" has ever previously been executed by any Circuit Court of Appeals, without at least giving the offender his *locus penitentiae*. In most of these cases, after the "scolding", the Court has received and considered the record as presented.

*United States* v. *Motion Picture Patents Co.*, (D. C., E. Div. Penna., 1916) 230 Fed. 541, 542;

*Carson* v. *Hurt*, (C. C. A. 5th Cir. 1918) 250 Fed. 30;

*Roxana Petroleum Co.* v. *Rush*, (C. C. A. 5th Circ. 1924) 295 Fed. 844;

*Buckeye Cotton Oil Co.* v. *Ragland*, (C. C. A. 5th Circ. 1926), 11 Fed. (2nd) 231;

*In re General Equity Rule*, 75 (C. C. A. 6th Circ. 1914) 222 Fed. 884;

*L. A. Westerman Co.* v. *Dispatch Printing Co.*, (C. C. A. 6th Circ. 1916) 233 Fed. 609;

*Firestone Tire & Rubber Co.* v. *Seberling*, (C. C. A. 6th Circ. 1916) 235 Fed. 891;

*Garland* v. *Quinn*, (C. C. A. 6th Circ. 1917) 242 Fed. 267;

*Goodwin* v. *United States*, (C. C. A. 6th Circ. 1924), 295 Fed. 856;

*Brictson Mfg. Co.* v. *Close*, (C. C. A. 8th Circ. 1922) 280 Fed. 297;

*Wong Krow* v. *United States*, (C. C. A. 7th Circ. 1914) 215 Fed. 95.

In such reported cases in which Equity Rule 75 (b) has been discussed as have resulted in affirmance of the judg-

ment, there has invariably been found some defect other than non-condensation of the record in the record upon which to base such affirmance.

*Buessel* v. *United States* (C. C. A. 2nd Cir. 1919) 258 Fed. 811, 822;

*Coxe* v. *Peck-Williamson Heating and Ventilating Co.* (C. C. A. 5th Cir. 1913) 208 Fed. 409;

*Wade* v. *Leach* (C. C. A. 5th Cir. 1924) 2 Fed. (2nd) 367.

In the instant case, viewed in the light most unfavorable either to the petitioner or its counsel, there has at most been a mere error of judgment into which the District Judge also fell. Petitioner's Counsel have throughout, in absolute good faith, earnestly endeavored to present to the appellate court a record in the form that they believed would be most acceptable to it, and which would enable its members most readily to assimulate its contents.

Reference is again made to Judge Page's assertion in the *Clark* case that "For fourteen years the courts have appealed to the bar to comply with this rule". Evidently, then, the purpose and effect of infliction of the "capital penalty" upon this petitioner is, in major part at least, to compel it to make a vicarious atonement for the faults of others. We believe that this Court will agree with us that the ends of justice do not require the affirmance of a judgment carrying a liability of nearly a million dollars without review upon the merits upon any such consideration. Such a penalty would be far too severe upon the litigant even if its counsel had intentionally disobeyed the rule, which it is thought has been conclusively shown not to be the case in this instance.

## CONCLUSION.

It is therefore respectfully submitted that even if the Circuit Court of Appeals had power to affirm the judgment

against petitioner upon the grounds stated in its opinion, it erred grievously in the exercise of its discretion in so doing without affording petitioner an opportunity to correct the unintentional failure of its counsel to comply with Equity Rule 75 as now sought to be administered by it. For the reasons stated, your petitioner respectfully prays that a writ of *certiorari* issue to enable this Court to review the decision of the Circuit Court of Appeals in this cause.

Respectfully submitted,

JOHN W. DAVIS,
CHARLES NEAVE,
SAMUEL E. HIBBEN,
HENRY N. PAUL,
Attorneys for Petitioner.

# APPENDIX A.

IN THE

DISTRICT COURT OF THE UNITED STATES,

FOR THE SOUTHERN DISTRICT OF ILLINOIS
SOUTHERN DIVISION.

| | |
|---|---|
| STANDARD ASPHALT AND RUBBER COMPANY, a corporation, vs. BARBER ASPHALT PAVING COMPANY, a corporation. | In Equity No. 25 |

This Cause came on to be heard upon the motion of the Barber Asphalt Paving Company filed herein on March 18, 1926, and upon the order of the Circuit Court of Appeals entered on January 29, 1926, certified copy of which is attached to said motion, and thereupon the said Barber Asphalt Paving Company, by its solicitors, Henry N. Paul and Logan Hay, presents to the Court the certified transcript of the record of this cause heretofore certified to the Circuit Court of Appeals and remitted by it on January 29, 1926, under the order of the Circuit Court of Appeals hereinabove referred to, and requests the Court to append its certificate of evidence to that part of the record which sets forth the testimony and other proceedings had and taken before this Court on the trial of said cause, and for such further amendment, correction or amplification as the District Court may see fit to make respecting the certification of the record, and also respecting the certification of certain printed copies of the specifications and drawings of four (4) United States patents as filed with the Accounting Master which are ap-

pended to the printed transcript in this case (pp. 4885 to 4907). And said Standard Asphalt and Rubber Company having been duly notified and appearing herein by A. F. Reichmann and Walter M. Allen, its counsel, appearing specially, solely and only for the purpose of challenging the power and jurisdiction of the Court to entertain the motion herein and to grant the relief herein prayed;

And the Court having heard the testimony of James M. Purcell, the official reporter who transcribed the testimony heard before the Honorable J. Otis Humphrey, deceased, and William J. Snyders, Deputy Clerk of this Court, finds:

1. That the sixteen volumes filed herein, one thereof on September 29, 1916, and fifteen thereof filed on January 17, 1917, together with the exhibits referred to therein and attached thereto, said volumes and exhibits being the testimony filed herein as referred to in the decree entered by Humphrey, Judge, February 20, 1917 and copies of which said volumes and exhibits are set forth at pages 24 to 1577, inclusive, of the printed transcript of record heretofore certified by the Clerk of this Court on June 29, 1925, are the full, true and complete transcript of all the proceedings had upon the hearing of this cause before the late Judge J. Otis Humphrey, including all the oral testimony, depositions, stipulations and exhibits which were introduced in evidence on the said hearing, and

2. That the instrument bearing on the cover in pencil the following: "Standard v. Barber, Defendant's Ex., Prior Art Patents, O. K. F. L. Belknap," containing among other things copies of the specifications forming part of Letters Patent Nos. 227945, 433198, 512348 and 512949, was filed by Bluford Wilson, Special Master in Chancery in this cause, with his report herein, and that said instrument contains the exhibits referred to on pages 3757, 3758, 3762 and 3764, inclusive, 3786 and 3788 inclusive, 3795 and 3796 inclusive, 3925 and 3936 inclusive wherein reference is made to letters Patent of the above numbers of the printed transcript of

record as certified by the Clerk of this Court, and was considered by this Court upon final hearing of this cause as exhibits reported by said Master in Chancery.

The Court therefore directs the Clerk of this Court to transcribe the said instrument described as: "Standard v. Barber, Defendant's Ex., Prior Art Patents, O. K. F. L. Belknap," by a supplemental transcript, to be certified to the Circuit Court of Appeals as part of the record of appeal in this cause.

And upon request of the said Defendant, the said Barber Asphalt Paving Company, the Court hereby directs that all the testimony in this cause be reproduced in the exact words of the witnesses, and not in narrative form.

And the Clerk of this Court is further directed to amend the transcript of record returned to this Court under the said order of the Circuit Court of Appeals, by adding thereto any file marks appearing upon the original stenographer's transcript of the proceedings at the trial as filed by the district judge and referred to by him in his interlocutory decree of February 20, 1917.

And pages 24 to 4872 inclusive of the transcript of record heretofore certified by the Clerk of this Court on June 29, 1925, amended and supplemented as herein directed, are hereby approved as a true, complete and properly prepared statement of the evidence (including testimony and exhibits therein referred to and the stipulation of the parties) in the above entitled cause.

And the Clerk of this Court is further directed to append to the original transcript of record herein a transcript of the order redocketing this cause in this court, the motion of Barber Asphalt Paving Company filed herein on March 18, 1926, and this order and thereupon to further certify said transcript of record and return the same to the Circuit Court of Appeals for the Seventh Circuit.

(Signed) Louis FitzHenry,
Judge.

Indorsed, Filed March 30, 1926, S. T. Burnett, Clerk.

# APPENDIX B.

IN THE

## UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE SEVENTH CIRCUIT.

OCTOBER TERM AND SESSION, 1926.

No. 3614.

| | |
|---|---|
| BARBER ASPHALT PAVING COMPANY, a Corporation, Appellant, vs. STANDARD ASPHALT & RUBBER COMPANY, a Corporation, Appellee. | Appeal from the District Court of the United States, for the Southern District of Illinois, Southern Division. |

December 13, 1926.

Before EVANS, PAGE and ANDERSON, *Circuit Judges*.

Opinion by PAGE, *Cir. J.*

The suit by appellee, called plaintiff, against appellant, called defendant, charged infringement of Culmer Patents Nos. 635429 and 635430. Judge Humphrey's decree, filed February 20, 1917, found infringement, ordered an accounting, and appointed a master to make an accounting. As the patents had expired, no injunction was ordered.

Judge Humphrey died in June, 1918. Judge FitzHenry, on April 30, 1924, entered a final decree on the accounting in favor of plaintiff. July 1, 1924, appeal was allowed, assignment of errors filed, and citation issued. Supersedeas bond

was filed July 5, 1924. On defendant's request, twelve thirty-day extensions of time for filing the record in this court were allowed, the last one expiring July 26, 1925.

On April 24, 1925, nearly 300 days after the citation, defendant served upon plaintiff a praecipe, in part as follows:

> "Please prepare a transcript of the record in the above entitled cause for use on appeal, including therein copies of the following: * * * Certificate of evidence, consisting of printed pages 24 to 1215, inclusive, pages 1222 to 4591, inclusive, and the following exhibits * * *."

Preceding that item, were requests for the pleadings and some other items. Following it, was a request for a portion of the exhibits. No condensed statement of the evidence was filed.

June 24, 1925, two days before the expiration of the last extension, the clerk of the District Court attached his certificate to the record. On July 3, 1925, one copy of the record was filed in this court. The required number of copies were filed November 2, 1925.

November 9, 1925, plaintiff moved to dismiss the appeal because no proper record had been filed here, one reason being that there was no certificate of evidence as required by Equity Rule 75. Sixty days thereafter, defendant moved to remit the record to the District Court for its certificate and for other purposes. January 29, 1926, that motion was allowed.

April 13, 1926, two years after the final decree, the District Court's certificate to the record was filed here.

As originally filed, the record, of nearly 5000 pages, was printed in nine volumes, apparently containing everything in the proceedings in the court below. Nothing was eliminated, nothing condensed. The court's belated certificate neither required nor made any change in the record already here, except in two particulars,—it did not certify, but directed the clerk of the District Court to certify, certain exhibits, which were already in the record, and to amend the

record and add "any file marks appearing upon the original stenographer's transcript, etc." The clerk complied with the first direction, but we are unable to determine whether or not he complied with the second. The court ordered, as a part of his certificate:

> "Upon the request of the said defendant * * * the court hereby directs that all the testimony in this cause be reproduced in the exact words of the witnesses, and not in narrative form."

The record is here, with the judge's certificate added, just as it came originally, except that the four exhibits, directed to be added by the clerk, are now in the record twice.

Plaintiff is insisting on its motion to dismiss for failure to comply with Equity Rule 75.*

Fourteen years ago, the Supreme Court, approving a record in a case then before it, said it was in compliance with the spirit of Rules 75, 76 and 77,

> "which call for just such a winnowing out of the useless; the presentation of only the relevant parts of the exhibits, documents, tables, and reports; and the elimination of all reduplications in written and oral testimony

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*75. RECORD ON APPEAL—REDUCTION AND PREPARATION. In case of appeal: (a) It shall be the duty of the appellant or his solicitor to file with the clerk of the court from which the appeal is prosecuted, together with proof or acknowledgment of service of a copy on the appellee or his solicitor, a *praecipe* which shall indicate the portions of the record to be incorporated into the transcript on such appeal. Should the appellee or his solicitor desire additional portions of the record incorporated into the transcript, he shall file with the clerk of the court his *praecipe* also within ten days thereafter, unless the time shall be enlarged by the court or a judge thereof, indicating such additional portions of the record desired by him.

(b) The evidence to be included in the record shall not be set forth in full, but shall be stated in simple and condensed form, all parts not essential to the decision of the questions presented by the appeal being omitted and the testimony of witnesses being stated only in narrative form, save that if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness. The duty of so condensing and stating the evidence shall rest primarily on the appellant, who shall prepare his statement thereof and lodge the

and a condensation into narrative form of what is material to the then issue before the court." (*Louisville & Nashville R. R. Co.* v. *U. S.*, 238 U. S. 11.)

Since then, the Supreme Court and many Courts of Appeal have pointed out the purpose of the rule and the necessity of observing it, but the condition of this record and of numerous other records before us at this term indicates that transition from the old practice to that under Rule 75 has been neither accomplished nor commenced.

By order of the Supreme Court, the rule became effective February 1, 1913. In 1914, the Sixth Circuit Court of Appeals, in *Re General Equity Rule 75 and Our Rule 15*, 222 Fed. 884, held that: without an order made at the term decree is entered, carrying the matter over to the next term, the court has the power, at a subsequent term, to approve and direct the filing of the statement of evidence required by Rule 75 (See also *Goodwin* v. *U. S.*, 295 Fed. (6th C. C. A., 1924) 856); that the perfection of the appeal by the approval of the bond and signing of citation yet leaves in the court the jurisdiction to settle the evidence, that proceeding being ministerial; that where the rule is wholly disregarded, the drastic

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same in the clerk's office for the examination of the other parties at or before the time of filing his *praecipe* under paragraph (a) of this rule. He shall also notify the other parties or their solicitors of such lodgment and shall name a time and place when he shall ask the court or judge to approve the statement, the time so named to be at least ten days after such notice. At the expiration of the time named or such further time as the court or judge may allow, the statement, together with any objections made or amendments proposed by any party, shall be presented to the court or the judge, and if the statement be true, complete and properly prepared, it shall be approved by the court or judge, and if it be not true, complete or properly prepared, it shall be made so under the direction of the court or judge and shall then be approved. When approved, it shall be filed in the clerk's office and become a part of the record for the purposes of the appeal.

(c) If any difference arise between the parties concerning directions as to the general contents of the record to be prepared on the appeal, such difference shall be submitted to the court or judge in conformity with the provisions of paragraph (b) of this rule, and shall be covered by the directions which the court or judge may give on the subject.

remedy of dismissal may be necessary; and, where the record reaches the court containing the evidence in full, general equity Rule 76 provides a remedy which, at least during the transition in general practice, will be sufficient. *Struett* v. *Hill*, 269 Fed. (9th C. C. A., 1920) adopted and followed the above practice. *Sussex Land & Livestock Co.* v. *Midwest Refining Co.*, 294 Fed. (8th C. C. A., 1923) 597, 600, followed the Sixth and Ninth Circuit holdings, *supra*. The rule was before the court, in an incidental way, in *U. S.* v. *Great Northern Ry. Co.*, 254 Fed. 522, 526 (9th C. C. A.) in 1918. In *Carson* v. *Hunt*, 250 Fed. (5th C. C. A., 1918) 30, 33, where a statement of the evidence was prepared by the parties but not approved by the court and there was nothing to show that it contained all the evidence, the court said it would be presumed that there was other evidence in the record to support the decree.

In *Buessel* v. *U. S.*, 258 Fed. (2nd C. C. A., 1919), 811, 822, the equity practice prior to the rule is reviewed. The court said:

> "Whatever may or may not have been the practice in this circuit prior to 1912 in the matter of preparing the record in an appeal, the subject is governed by rules 75, 76 and 77, as framed by the Supreme Court, and that there is no power in this court to exempt a particular case from their operation. The rules, having been promulgated under the authority of an act of Congress, have the authority of statutory regulation. *Winter* v. *Ludlow*, 104 Fed. Cas. No. 17,891."

The court further said:

> "As the testimony in the transcript in this case is not there in conformity to Rule 75 we cannot consider it."

In *Buckeye Cotton Oil Co.* v. *Ragland*, 11 Fed. (2d) (5th C. C. A., 1926) 231, 232, the court said:

> "We are of opinion that equity rule 75 does not contemplate that the trial court will order all the testimony in a case sent up in question and answer form. If particular answers of a witness are subject to different interpre-

tions, the questions which elicited such answers frequently aid in determining which interpretation is correct. For that reason the rule provides, by way of exception, 'that if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness.' The rule was designed to prevent the imposition of such a record as this upon an appellate court. *Newton* v. *Consolidated Gas Co.*, 258 U. S. 165, 42 S. Ct. 264, 66 L. Ed. 538; *Houston* v. *Telephone Co.*, 259 U. S. 318, 42 S. Ct. 486, 66 L. Ed. 961. * * * We will not enforce the rule in this case, but only for the reason that counsel might have construed the order allowing the appeal to authorize the record in its present shape."

In *Re Jewell Electrical Instrument Co.*, 283 Fed. (7th C. C. A., 1922) 978, 980, this court said:

"It is needless to test whether appellant's proposition is sustained by its citations of *Conn* v. *Penn*, 5 Wheat. 424, *Blease* v. *Garlington*, 92 U. S. 1, and *First Nat. Bank* v. *Abbott*, 165 Fed. 852, under former rules, for under present equity rule 46 respecting oral testimony in open court and equity rule 75, concerning an appellant's duty to procure the trial judge's certification of the evidence (like a bill of exceptions on the law side) and his duty to file it with the clerk of the trial court and his duty to include within his praecipe those portions of the record which establish the existence of error in the decree, there is no room for contending that error must be presumed."

In *Newton* v. *Consolidated Gas Co.*, 258 U. S. 165, 173 (1911)* the court said, in part:

"Equity Rules 75 and 76 direct that records on appeal shall not set forth the evidence fully but in simple condensed form and require omission of non-essentials and mere formal parts of documents. Without apparent attempt to comply with these rules and with assent of appellee's counsel, appellants in No. 257 have filed a record of 21 volumes—twenty thousand printed pages—made up largely of stenographic reports of proceedings before the

*Sic in original.

> Master with hundreds of useless exhibits and many thousand pages of matter without present value. This is indefensible practice which we shall hereafter feel at liberty to punish to the limit of our discretion—possibly by dismissal of the appeal. These rules were intended to protect the courts against useless, burdensome records and litigants from unnecessary costs and delay. Counsel ought to comply with them, and trial courts should enforce performance of this plain duty."

See also *Peterson* v. *Mobile Gas Co.*, 271 U. S. 131.

In *Houston* v. *Southwestern Tel. Co.*, 259 U. S. 318, 325 (1921), the court said:

> "Equity rule No. 75 provides that evidence to be included in the record shall not be set forth in full but shall be stated in a simple and condensed form, and Rule 21 of this court provides that briefs of the argument shall be filed in each case, with references to the pages of the record and the authorities relied upon in support of each point. The first of these rules has been wholly ignored in the printing of this record and the second has been so neglected in the preparation of the briefs that it is impossible for the court to consider this question except by itself reading and briefing the voluminous record. This we cannot consent to do, and for the reason that the record and briefs are not prepared in conformity with the rules prescribed by this court, we decline to consider this assignment of error."

Outstanding provisions of the rule are that: (a) all parts of the evidence not essential to the decision presented by appeal shall be omitted; (b) the evidence shall not be set forth in full, but shall be stated in condensed form; (c) testimony of witnesses shall be stated only in narrative form, save that the court may direct any part of the testimony to be reproduced in the exact words of the witness; (d) the burden of preparing the statement of the evidence, filing it with the clerk at or before the time of filing the praecipe, notifying the appellee and fixing a date for hearing before the judge,

are placed on the appellant; (e) when the parties and the court have made up a statement that is "true, complete and properly prepared," the court is empowered and required to approve it. Excuse for not complying with (a), (b) and (c) is not attempted. For failure, during the two years between the final decree and the District Court's certificate, to comply with (d) no reason is offered. Since then it is urged that the court ordered as follows:

> "Upon request of said defendant * * * the court hereby directs that all the testimony in this case be reproduced in the exact words of the witnesses."

It is not within the power of the District court or judge to make such an order. The order is not in harmony with the spirit of Rule 75. The equity rules have the force of statutory enactments. *Buessel* v. *U. S., supra.* The duty of the court or judge in connection with the preparation of the statement is set out in the rule. The only power of approval vested in the court is found in the following language of the rule:

> "If the statement" (when presented) "be true, complete and properly prepared, it shall be approved by the court or judge."

That must mean that it shall comply with the rule.

In a proper statement, the evidence: (a) *must be condensed;* (b) *all parts not essential to a decision of the questions on appeal shall be omitted;* and (c) *the testimony of witnesses must be stated in narrative form only,* with the single exception,

> "That if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness."

That provision means that when the court or judge, being familiar with the evidence, finds that to properly present the

questions on appeal it is desirable that a part of the testimony of a witness shall be reproduced in his exact words, he may so direct. It is not within the purpose and spirit of the rule to put in a statement the whole of the testimony of any witness or of all the witnesses.

No question raised by the errors assigned can be determined without a consideration of the evidence, and, it not being properly before us, the decree is affirmed.

# APPENDIX C.

IN THE

## UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE SEVENTH CIRCUIT.

OCTOBER TERM AND SESSION, 1926.

No. 3740.

| | |
|---|---|
| R. W. CLARK MANUFACTURING COMPANY, *Appellant*, vs. TABLET & TICKET COMPANY, *Appellee*. | Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division. |

December 22, 1926.

Before ALSCHULER, EVANS and ANDERSON, *Circuit Judges*.

EVANS, *Cir. J.*: This appeal involves the validity and the infringement of patent No. 1,207,711. It calls for an examination of the evidence disclosing the prior art and the alleged prior public use of the patented article. No question other than one of fact is involved.

There has been a total failure to comply with Supreme Court Equity Rule 75 in the preparation of the testimony. In short, there has been no effort made to condense or to eliminate unnecessary portions, or to put in narrative form the material testimony of the witnesses.

In view of the policy adopted by this court in *Barber Asphalt Paving Co. v. Standard Asphalt & Rubber Co.*, and

followed in other cases announced at this term, we can not review the record to ascertain whether the evidence supports the decree.

The Barber Asphalt case was announced in the belief that the only effective way to secure a compliance with this Rule 75 is to enforce it. And obviously it can not be enforced in one case and ignored in another.

It was the flagrant abuse of Equity Rule 75 that lead to the promulgation of this decision, an abuse that resulted in great delay and needless expense to the litigants, and to the imposition of an unfair burden on the court. The litigants have a right to expect the courts to relieve them of this unnecessary expense, and the unnecessary delay, which unavoidably follows an attempt to dispose of litigation in such an awkward and cumbersome manner. For fourteen years the courts have appealed to the bar to comply with the rule. They have scolded and they have threatened, and yet the records in patent suits have grown longer and longer, and are loaded more and more useless documents and irrelevant testimony.

In almost all state appellate courts, a rule similar to this one exists and is enforced. The Federal courts enforce a similar rule respecting bills of exceptions in common law actions. *Jones* v. *G. & B. Sewing Machine Co.*, 131 U. S. App. cl; *Mueller* v. *Ehlers*, 91 U. S. 249

This rule is followed generally in the federal courts save by a limited branch of the profession. We feel confident that once it is cheerfully accepted by this group, its advantages will be uniformly recognized.

The decree is affirmed.

## APPENDIX D.

ALSCHULER, *Cir. J.*, dissenting: Assuming to follow the policy adopted in the Barber Asphalt Paving Company case (Dec. 13, 1926), and stating in the majority opinion herein that Rule 75 "cannot be enforced in one case and ignored in another," it seems that my brethren have concluded *sua sponte* to affirm the decree in this and all other equity appeals which we have heretofore heard and are pending for decisions, where the evidence necessary to be considered in deciding the cause appears in the transcript in question and answer form, without condensation and approval as required by Rule 75.

I cannot in this appeal, nor in others in like situation, give assent to affirmance of the decree, because only of transgression of the rule.

While in Barber Asphalt the appellee insistently moved and urged dismissal of the appeal because of noncompliance with the rule, in this case, as in most, if not all the others, the transcript was prepared under stipulation of counsel for all parties, and consent of the trial judge. Here there is also a stipulated order of this court entered upon my direction, permitting the use on this appeal of such transcript. The briefs were prepared and oral arguments made and heard evidently on the faith of counsel, as well as court, that the transcript was in this respect unobjectionable—or at least acceptable.

Notwithstanding the rule, the most usual practice in most districts of this circuit, in the preparation of transcripts for equity appeals—particularly in patent cases—has been for counsel to stipulate that an uncondensed shorthand report of the oral testimony be incorporated in the transcript, and for the trial judge, by order or endorsement on the transcript, to consent thereto; and so far as my judicial experience extends, and the reports indicate, this court has always heard such appeals and disposed of them on their merits, no ques-

tion as to observance of the rule being raised by court or counsel.

I can agree that the seemingly broad exception to the operation of Rule 75(b), viz: "save if either party desires it, and the court or judge so directs, any part of the testimony shall be reproduced in the exact words of the witness," does not contemplate that by the trial judge's perfunctory assent to such stipulation of counsel, observances of the rule may be avoided; and, further, that such consent is usually an improvident and unwarranted application of the saving clause. *Firestone Tire, etc. Co.* v. *Scberling*, 235 Fed. 891; *Buckeye Cotton Oil Co.* v. *Ragland*, 11th Fed. (2d) 522. Also, that such order of consent by the Circuit Court of Appeals or any judge thereof, as was made in this case, is likewise improvident and objectionable and should not have been made.

I do not know what the practice in this respect has been in other circuits. That there have been transgressions with which they, as well as the Supreme Court, have dealt, the reported decisions indicate. But notwithstanding the fourteen years' existence of the rule, I have yet to find the first instance where a federal court of appellate jurisdiction has affirmed a decree in equity or dismissed the appeal for failure to make and to have certified a condensed statement of the evidence.

Indeed, without the statement by the Supreme Court in *Newton* v. *Consolidated Gas Co.*, 258 U. S. 165, that in case of such transgression thereafter, that court will feel at liberty to penalize the transgressor "to the limit of our discretion—possibly by dismissal of the appeal," (which in that case was not done, but the 20,000-page uncondensed transcript considered on its merits), it might well have been doubted whether the consequence of noncompliance could properly extend beyond such penalization as might come through the awarding or withholding of costs. For Rule 76, after providing for the exclusion of immaterial parts of documents and papers, states: "and for any infraction of this or any kindred rule

the appellate court may withhold or impose costs as the circumstances of the case and the discouragement of like infractions in the future may require. Costs for such an infraction may be imposed upon the offending solicitors as well as parties." And which of the equity rules is more kindred to Rule 76 than 75?

But accepting affirmance or dismissal as a permissible consequence of noncompliance with Rule 75, the very fact that, as appears from the cases cited in the Barber Asphalt opinion, and in others, the courts did not impose it, but quite generally overlooked the transgression in the particular case, and determined it on its merits, makes it apparent that the manner and extent of penalization rests with the court wherein the appeal is pending.

My contention is, not that this court is without power in a proper case to impose dismissal or affirmance as a consequence of the infraction, but that this court's long acquiescence in the practice here followed makes it highly inequitable here to impose the capital penalty of affirmance without first affording opportunity to comply with the rule, in whose long non-observance this court has, at least impliedly, seemed to invite litigants to continue.

I believe that in this case such opportunity could and should have been given, and that affirmance on the court's own motion, without reasonable opportunity for compliance, is an unreasonable exercise of the court's discretion.

I believe this court has the power to make such an order, and the district judge thereupon to certify a proper statement of the record, notwithstanding the term has passed; and am in accord with the Sixth C. C. A. in its statement that where an appeal has been taken in apt time, the preparation of the record to comply with Rule 75(b) is a ministerial matter, to which the district court or judge may certify at any time, regardless of terms of court. *Re General Equity Rule 75*, 222 Fed. 884; also *Struett v. Hill*, 269 Fed. 247; *Sussex Land, etc. Co. v. Midwest Ref. Co.*, 294 Fed. 597.

Such course would cause some delay and expense, but the parties affected could not properly complain since by their stipulation, albeit made in good faith, they became the prime factors in transgression of the rule.